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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,945	06/07/2000	Alessandro Betta	Q59243	9051

7590 11/18/2003

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EXAMINER

NGUYEN, TOAN D

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/588,945

Applicant(s)

BETTA ET AL.

Examiner

Toan D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the application number and the filing date of the specification are not filled out in the blank on page 1 of Declaration.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6 and 16 are rejected under 35 U.S.C. 101 because a telecommunication signal frame comprising a section overhead (SOH) with a Regeneration Section OverHead (RSOH) comprising in turn a first byte (K1) and a second byte (K2), said first byte (K1) comprising bits (a<sub>K15</sub>, a<sub>K16</sub>, a<sub>K17</sub>, a<sub>K18</sub>) identifying the destination node and said second byte (K2) comprising bits (a<sub>K21</sub>, a<sub>K22</sub>, a<sub>K23</sub>, a<sub>K24</sub>) identifying the source node, wherein said Multiplex Section OverHead (MSOH) comprises a third byte (K0) comprising at least one Source Node Identification Extension bit (a<sub>K05</sub>, a<sub>K06</sub>; a<sub>K03</sub>, a<sub>K04</sub>, a<sub>K05</sub>), at least one Destination Node Identification Extension bit (a<sub>K07</sub>, a<sub>K08</sub>; a<sub>K06</sub>, a<sub>K07</sub>, a<sub>K08</sub>) and at least one bit (a<sub>K01</sub>, a<sub>K02</sub>, a<sub>K03</sub>, a<sub>K04</sub>; a<sub>K01</sub>, a<sub>K02</sub>) indicating a change of the information in said first and/or second and/or third bytes (K1, K2, K0).

Claims 1-6 and 16 in question can be considered in view of Water, 205USPQ 397 at 407, (CCPA, 1980), "if the end-product of a claimed invention is a pure member, as in Bension and

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Flook, the invention is non-statutory regardless of any post-solution activity which makes it available for use by a person or machine for other purposes,” so as to avoid the > 35 U.S.C < 101 rejection. Similarly, preliminary data gathering step may not affect the subject matter as a whole assessment.”

***Claim Rejections - 35 USC § 112***

4. Claims 1, 6-7, 11, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 5, recites the limitation “said Multiplex Section OverHead (MSOH)” lack clear antecedent basis.

In claim 6 line 2, “the first STM-1” lack clear antecedent basis.

In claim 7 line 2, “the Multiplex Section OverHead (MSOH)” lack clear antecedent basis.

In claim 7 line 4, “the number of nodes” lack clear antecedent basis.

In claim 7 lines 6 and 8, it is unclear as to what is meant by “at least one of them”. The scope of the claim is, therefore, unascertainable.

In claim 11 line 2, “lest” should be --- least ---.

In claim 14 lines 2-3, it is unclear as to what is meant by “adapted to perform the algorithm indicated in claim 12 or 13, when said program is run in a computer”. Similar problem exists in claim 15 lines 2-4.

Claims 2-5, 8-10 and 12-13 are rejected since they are dependent form base claim.

***Contact Information***

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D Nguyen whose telephone number is 703-305-0140. The examiner can normally be reached on Monday- Friday (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 703-308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

*Toan D. Nguyen*

Toan D. Nguyen